UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 January 2008*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This communication is in response to the Amendment filed 11 January 2008.

2.   Claims 1-18 are currently pending. In the Amendment filed 11 January 2008,

none of the claims were amended. This action is made Non-Final.

3.   The rejections of claims 1-5, 7-12 and 14-18 as being unpatentable over US

PGPub 2006/0020586 to Prompt et al in view of US PGPub 2001/0011247 to O'Flaherty

et al and of claims 6 and 13 as being unpatentable over US PGPub 2006/0020586 to

Prompt et al in view of US PGPub 2001/0011247 to O'Flaherty et al in view of US

Patent No 5,850,480 to Scanlon have been withdrawn.

Claim Clarifications - 35 USC § 101

4.   Claims 1-7 are directed towards an apparatus. The claimed apparatus is

construed as including the necessary hardware since according to page 5 of applicant's

specification, Fig 12 illustrates a hardware configuration of the database management

apparatus.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

6.   **Claims 15-18** are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

7.   **Claim 15-17** is directed towards a computer program. The program is merely

functional descriptive material. In order for the program to permit the function of the

descriptive material to be realized, it needs to be stored on some computer-readable

medium. Since the claim language fails to include the necessary medium, the claim is

directed towards non-statutory subject matter.

> According to MPEP 2106:
>
> The claims lack the necessary physical articles or objects to constitute a machine
> or a manufacture within the meaning of 35 USC 101. They are clearly not a
> series of steps or acts to be a process nor are they a combination of chemical
> compounds to be a composition of matter. As such, they fail to fall within a
> statutory category. They are, at best, functional descriptive material *per se.*
>
> Descriptive material can be characterized as either "functional descriptive
> material" or "nonfunctional descriptive material." Both types of "descriptive
> material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d
> at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded
> on some computer-readable medium, it becomes structurally and functionally
> interrelated to the medium and will be statutory in most cases since use of
> technology permits the function of the descriptive material to be realized.
> Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir.
> 1994)
>
> Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on
> a computer-readable medium, in a computer, or on an electromagnetic carrier
> signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8
> (noting that the claims for an algorithm in *Benson* were unpatentable as abstract
> ideas because "[t]he sole practical application of the algorithm was in connection
> with the programming of a general purpose computer.").

Since **claims 16 and 17** are dependent on claim 15 and fail to overcome the

deficiencies of claim 15, the claims are rejected on the same grounds as claim 15.

8.   **Claim 18** is directed towards "a computer-readable recording medium."

According to page 19, lines 11-22 of the applicant's specification, an example of the

recording medium is communication mediums. Therefore, when the term is interpreted

by one of ordinary skill in the art, the term can be construed to cover non-statutory

embodiments which improperly include network transmission lines (interpreted as wired

and wireless transmission), wireless transmission media, signals propagating through

space, radio waves, infrared signals, etc.

See, e.g., In re Nuitjen, Docket no. 2006-1371 (Fed. Cir. Sept. 20, 2007)(slip. op.

at 18) "A transitory, propagating signal like Nuitjen's is not a process, machine,

manufacture, or composition of matter.' ... Thus, such a signal cannot be patentable

subject matter."

Therefore, the claimed subject matter fails to fall within on of the four statutory

classes.

According to MPEP 2106:

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

9.   To allow for compact prosecution, the examiner will apply prior art to these

claims as best understood, with the assumption that applicant will amend to overcome

the stated 101 rejections.

Claim Rejections - 35 USC § 102

10.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11.   Claims 1-18 are rejected under 35 U.S.C. 102(a) as being anticipated by US

PGPub 2003/0009475 to Kayamoto et al (hereafter Kayamoto).

Referring to claim 1, Kayamoto discloses a database management apparatus

that performs a search of data from a database based on predetermined information

selected by a user from among information registered as a dictionary, the database

management apparatus comprising:

a table storing unit [data mart 21] for storing in the database common data

accessible to a predetermined user and other users, said table storing unit including a

personal table storing unit that stores in the database personal data built by data

entered by the predetermined user (see [0051]; [0056] and Fig 1);

a dictionary registering unit [information management dictionary 22] for storing

common information on either of or both management and analysis data stored in the

database in a common dictionary accessible by the predetermined user and the other

users (see [0041]; [0048]; and Fig 1), said dictionary registering unit including a

personal dictionary registering [personal dictionary managing information such as the

management points created by an ordinary user] unit that registers personal information

on either of or both management and analysis of the personal data and the common

data stored in the database to a personal dictionary that is accessible only by the

predetermined user (see [0056] and [0059]; and Fig 1), and

a dictionary reference unit that outputs the personal information to the

predetermined user, and accepts a selection of either or both management and analysis

of the personal data and the common data by the predetermined user from the personal

information (see [0072]-[0076]); and

a searching unit that performs a search of data from a database storing the

personal data and the common data based on the selection accepted by the dictionary

reference unit (see [0057]-[0059] and [0072]-[0075]).

Referring to claims 2 Kayamoto discloses the database management apparatus

according to claim 1, wherein

the personal table storing unit [data mart 21] that stores in the database the

personal data obtained as a result of the search (see [0051]; [0056] and Fig 1), and

the personal dictionary registering unit [personal dictionary managing information

such as the management points created by an ordinary user] registers the personal

information on either of or both management and analysis of the personal data and the

common data stored in the database to the personal dictionary that is accessible only

by the predetermined user who made a request for the search (see [0056] and [0059];

and Fig 1).

Referring to claim 3, Kayamoto discloses the database management apparatus

according to claim 1, wherein

the personal table storing unit stores, upon the database management apparatus

receiving a request to store the personal data having a predetermined file format, the

personal data having the predetermined file format to the database [database type] (see

[0055] and [0089]), and

the personal dictionary registering unit registers the personal information on

either of or both management and analysis of the personal data and the common data

stored in the database to the personal dictionary that is accessible only by the

predetermined user who made the request (see [0056] and [0059]; and Fig 1).

Referring to claim 4, Kayamoto discloses the database management apparatus

according to claim 1, wherein

the personal dictionary registering unit registers, upon the database management

apparatus receiving a request to register the personal information on a predetermined

operation applied to the data of the database, the personal information on the

predetermined operation to the personal dictionary that is accessible only by the

predetermined user who made the request (see [0056] and [0059]; and Fig 1), and

the dictionary reference unit outputs the personal information to the

predetermined user, and accepts the selection of either of or both management and

analysis of the personal data and the common data by the predetermined user from the

personal information (see [0056] and [0059]; and Fig 1).

Referring to claim 5, Kayamoto discloses the database management apparatus

according to claim 1, wherein

the personal dictionary registering unit registers, upon the database management

apparatus receiving a request to register the personal information on a link between the

data of the database, the personal information on the link to the personal dictionary that

is accessible only by the predetermined user who made the request (see Fig 3 and

associated text), and

the dictionary reference unit outputs the personal information to the

predetermined user, and accepts the selection of either of or both management and

analysis of the personal data and the common data by the predetermined user from the

personal information (see [0056] and [0059]; and Fig 1).

Referring to claim 6, Kayamoto discloses the database management apparatus

according to claim 1, wherein

the personal dictionary registering unit registers, upon the database management

apparatus receiving a request to register the personal information on a composite field

that is formed by combining a plurality of data fields of the database, the personal

information on the composite field to the personal dictionary that is accessible only by

the predetermined user who made the request (see Fig 3 and associated text), and

the dictionary reference unit outputs the personal information to the

predetermined user, and accepts the selection of either of or both management and

analysis of the personal data and the common data by the predetermined user from the personal information (see [0056] and [0059]; and Fig 1).

Referring to claim 7, Kayamoto discloses the database management apparatus according to claim 1, wherein

the personal dictionary registering unit registers, upon the database management apparatus receiving a request to register management point information on either of or both management and analysis of the data stored in the database as the personal information, management point information to the personal dictionary that is accessible only by a user who made the request (see Fig 3 and associated text), and

the dictionary reference unit outputs the personal information to the predetermined user, and accepts the selection of either or both management and analysis of the personal data and the common data by the predetermined user from the personal information (see [0056] and [0059]; and Fig 1).

Referring to claim 8, Kayamoto discloses a database management method to perform a search of data from a database based on predetermined information selected by a user from among information registered as a dictionary, the database management method comprising:

storing in the database common data accessible to a predetermined user and other users, and personal data built by data entered by the predetermined user [data mart 21] (see [0051]; [0056] and Fig 1);

storing the common information on either of or both management and analysis data stored in the database in a common dictionary accessible by the predetermined

user and the other users [information management dictionary 22] (see [0041]; [0048];

and Fig 1), and registering personal information on either of or both management and

analysis of the personal data and the common data stored in the database to a personal

dictionary that is accessible only by the predetermined user [personal dictionary

managing information such as the management points created by an ordinary user]

(see [0056] and [0059]; and Fig 1;

outputting the personal information to the predetermined user (see [0072]);

accepting a selection of either or both management and analysis of the personal

data and the common data by the predetermined user from the personal information

(see [0072]-[0076]); and

performing a search of data from the personal data and the common data based

on the selection accepted (see [0057]-[0059] and [0072]-[0075]).

Referring to claims 9 Kayamoto discloses the database management method

according to claim 8, wherein

the storing includes storing in the database the personal data obtained as a

result of the search (see [0051]; [0056] and Fig 1), and

the registering including registering the personal information on either of or both

management and analysis of the personal data and the common data stored in the

database to the personal dictionary that is accessible only by the predetermined user

who made a request for the search (see [0056] and [0059]; and Fig 1).

Referring to claim 10, Kayamoto discloses the database management method

according to claim 8, wherein

the storing includes storing, upon receiving a request to store the personal data

having a predetermined file format, the personal data having the predetermined file

format to the database [database type] (see [0055] and [0089]), and

the registering includes registering the personal information on either of or both

management and analysis of the personal data and the common data stored in the

database to the personal dictionary that is accessible only by the predetermined user

who made the request (see [0056] and [0059]; and Fig 1).

Referring to claim 11, Kayamoto discloses the database management method

according to claim 8, wherein

the registering includes registering, upon receiving a request to register the

personal information on a predetermined operation applied to the data of the database,

the personal information on the predetermined operation to the personal dictionary that

is accessible only by the predetermined user who made the request (see [0056] and

[0059]; and Fig 1), and

the outputting includes outputting the personal information to the predetermined

user, and the accepting includes accepting the selection of either of or both

management and analysis of the personal data and the common data by the

predetermined user from the personal information (see [0056] and [0059]; and Fig 1).

Referring to claim 12, Kayamoto discloses the database management method

according to claim 8, wherein

the registering includes registering, upon receiving a request to register the

personal information on a link between the data of the database, the personal

information on the link to the personal dictionary that is accessible only by the

predetermined user who made the request (see Fig 3 and associated text), and

the outputting includes outputting the personal information to the predetermined

user, and accepting includes accepting the selection of either of or both management

and analysis of the personal data and the common data by the predetermined user from

the personal information (see [0056] and [0059]; and Fig 1).

Referring to claim 13, Kayamoto discloses the database management method

according to claim 8, wherein

the registering includes registering, upon receiving a request to register the

personal information on a composite field that is formed by combining a plurality of data

fields of the database, the personal information on the composite field to the personal

dictionary that is accessible only by the predetermined user who made the request (see

Fig 3 and associated text), and

the outputting includes outputting the personal information to the predetermined

user, and accepting includes accepting the selection of either of or both management

and analysis of the personal data and the common data by the predetermined user from

the personal information (see [0056] and [0059]; and Fig 1).

Referring to claim 14, Kayamoto discloses the database management method

according to claim 8, wherein

the registering includes registering, upon receiving a request to register

management point information on either of or both management and analysis of the

data stored in the database as the personal information, the management point

information to the personal dictionary that is accessible only by a user who made the

request (see Fig 3 and associated text), and

the outputting includes outputting the personal information to the predetermined

user, and the accepting includes accepting the selection of either or both management

and analysis of the personal data and the common data by the predetermined user from

the personal information (see [0056] and [0059]; and Fig 1).

Referring to claim 15, Kayamoto discloses a computer program for managing a

database to perform a search of data from a database based on predetermined

information selected by a user from among information registered as a dictionary, the

computer program making a computer execute:

storing in the database common data accessible to a predetermined user and

other users, and personal data built by data entered by the predetermined user [data

mart 21] (see [0051]; [0056] and Fig 1);

storing the common information on either of or both management and analysis

data stored in the database in a common dictionary accessible by the predetermined

user and the other users [information management dictionary 22] (see [0041]; [0048];

and Fig 1), and registering personal information on either of or both management and

analysis of the personal data and the common data stored in the database to a personal

dictionary that is accessible only by the predetermined user [personal dictionary

managing information such as the management points created by an ordinary user]

(see [0056] and [0059]; and Fig 1;

outputting the personal information to the predetermined user (see [0072]);

accepting a selection of either or both management and analysis of the personal

data and the common data by the predetermined user from the personal information

(see [0072]-[0076]); and

performing a search of data from the personal data and the common data based

on the selection accepted (see [0057]-[0059] and [0072]-[0075]).

Referring to claims 16, Kayamoto discloses the computer program according to

claim 15, wherein

the storing includes storing in the database the personal data obtained as a

result of the search (see [0051]; [0056] and Fig 1), and

the registering including registering the personal information on either of or both

management and analysis of the personal data and the common data stored in the

database to the personal dictionary that is accessible only by the predetermined user

who made a request for the search (see [0056] and [0059]; and Fig 1).

Referring to claim 17, Kayamoto discloses the computer program according to

claim 15, wherein

the storing includes storing, upon receiving a request to store the personal data

having a predetermined file format, the personal data having the predetermined file

format to the database [database type] (see [0055] and [0089]), and

the registering includes registering the personal information on either of or both

management and analysis of the personal data and the common data stored in the

database to the personal dictionary that is accessible only by the predetermined user

who made the request (see [0056] and [0059]; and Fig 1).

Referring to claim 18, Kayamoto discloses a computer-readable recording

medium for storing a computer program for realizing a database management to

perform a search of data from a database based on predetermined information selected

by a user from among information registered as a dictionary, the computer program

making a computer execute:

storing in the database common data accessible to a predetermined user and

other users, and personal data built by data entered by the predetermined user [data

mart 21] (see [0051]; [0056] and Fig 1);

storing the common information on either of or both management and analysis

data stored in the database in a common dictionary accessible by the predetermined

user and the other users [information management dictionary 22] (see [0041]; [0048];

and Fig 1), and registering personal information on either of or both management and

analysis of the personal data and the common data stored in the database to a personal

dictionary that is accessible only by the predetermined user [personal dictionary

managing information such as the management points created by an ordinary user]

(see [0056] and [0059]; and Fig 1;

outputting the personal information to the predetermined user (see [0072]);

accepting a selection of either or both management and analysis of the personal

data and the common data by the predetermined user from the personal information

(see [0072]-[0076]); and

performing a search of data from the personal data and the common data based

on the selection accepted (see [0057]-[0059] and [0072]-[0075]).

Response to Arguments

12.   Applicant's arguments with respect to claims 1-18 have been considered but are

moot in view of the new ground(s) of rejection.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMBERLY LOVEL whose telephone number is (571)272-2750. The examiner can normally be reached on 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John R. Cottingham/   Kimberly Lovel
Supervisory Patent Examiner, Art Unit 2167   Examiner
                                                        Art Unit 2167

kml
24 April 2008